

#### **D. REMARKS**

Applicants respectfully request reconsideration of the outstanding rejections and reexamination of the present application in light of the following amendments and remarks.

#### ***Status of the Claims***

Claims 1, 7, and 15 are currently pending in the application and are currently amended.

#### ***Interview Summary***

Applicants appreciate the Examiner's willingness to provide a telephone interview on September 11, 2009, to discuss proposed amendments to the claims. Applicants have amended the claims per the discussion during the telephone interview and appreciate the Examiner's willingness to call Applicant's to discuss an Examiner's amendment should any additional amendments be required to overcome the rejections.

#### ***35 USC 101***

The Office Action rejects claim 1 based on 35 USC 101. In particular, the Office Action states:

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). Thus, to qualify as a §101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. (See Memorandum from John 1. Love, Deputy Commissioner for Patent Examination Policy, dated January 7, 2009) There are two corollaries to the machine-or-transformation test set forth in the memorandum. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent eligible. The apparatus must impose meaningful limits on the method claim's scope to pass the test.

Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting is not sufficient to pass the test. Applicant's method steps fail the second prong of the new Federal Circuit decision since they only recite displaying data on a user interface which is considered insignificant extra solution activity. Thus, claim 1 is non-statutory. [Office Action, pp. 3-4]

Applicants respectfully submit that claim 1, as amended, recites statutory subject matter under 35 USC § 101. In particular, Applicants note that claim 1 is amended to recite a process that under the broadest reasonable interpretation of the claim in view of the specification consistent with the interpretation those skilled in the art would reach is clearly tied to a particular machine or apparatus and the particular machine imposes a meaningful limit on the claim's scope and involves more than insignificant "extra-solution" activity. For example, claim 1 is amended to teach each of the elements performed using a processor, where there is a particular machine the claim recites a particularly programmed processor and where the machine imposes a meaningful limit and it is more than insignificant extra-solution activity. Applicants respectfully request withdrawal of the rejection under 35 USC 101 as to claim 1.

The Office Action rejects claim 7 based on 35 USC 101. In particular, the Office Action states:

Claim 7 is rejected as being directed toward non-statutory subject matter because it is software per se. Claim 7 recites "computer readable medium". The specification, paragraph does not specify what medium is intended for use. Given the broadest reasonable interpretation, Examiner construes the medium to include signals and/or carrier waves. Signals are not statutory under 35 USC 101. To properly determine whether a claimed invention complies with the statutory invention requirements of 35 U.S.C. 101, USPTO personnel must first identify whether the claim falls within at least one of the four enumerated categories of patentable subject matter recited in section 101 (i.e., process, machine, manufacture, or composition of matter). A claim directed to a signal per se does not appear to be a process, machine, manufacture, or composition of matter. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer readable medium, in a computer, or on an electromagnetic carrier

signal, does not make it statutory. See >Diamond v.< Diehr, 450 U.S. \*>175,< 185-86,209 USPQ \*>1,< 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). MPEP 2106.01 [R-6] [Office Action, pp. 4-5]

During the telephone interview, the Examiner noted that the basis of the rejection is that paragraph 0040 of the specification includes signals, which are nonstatutory.

Applicants have amended paragraph 0040 herein to remove references to signals, and respectfully request withdrawal of the rejection of claim 7 under 35 USC 101 and allowance of the claim.

***35 USC 112, second paragraph***

The Office Action rejects claim 15 under 35 USC 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Office Action states:

"The use of "that" is indefinite because it is not clear whether or not the system elements are actually performing the function that follows the "that" language, i.e., said functionality is not recited. For example, it is stated "a processing unit that generates an invitation list, but it does not distinctly claim this function. An alternative would be - a processing unit configured to generate an invitation list -- this is just one example, there are several occurrences of the "that" in claim 15. Please make corrections. Examiner recommends replacing each instance of "that" with the phrase "configured to" or "programmed to"." [Office Action, p. 5]

Applicants do not concede that claim 15 is indefinite under 35 USC 112, second paragraph, however Applicants amend claim 15 to clarify that the functionality of each system elements is recited. Applicants note that pages 8-12 of the specification describe the claimed system element functionality. Applicants respectfully request withdrawal of the rejection of claim 15 under 35 USC 112, second paragraph and allowance of the claim.

***Conclusion***

Applicants note the citation of pertinent prior art cited by the Examiner.

In view of the foregoing, withdrawal of the rejections and the allowance of the current pending claims is respectfully requested. If the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

No extension of time is believed to be necessary. If, however, an extension of time is required, the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

By /Amy J. Pattillo, Reg. No. 46,983/

AMY J. PATTILLO

Registration No. 46,983

P.O. BOX 161327

AUSTIN, TEXAS 78716

ATTORNEY FOR APPLICANTS

Telephone: 512-402-9820

Facsimile: 512-306-0417